

REMARKS

After over six years of awaiting the declaration of an interference on claims copied from U.S. Patent no. 5,499,108 to Cotte et al, and demonstrated (in amendment of October 14, 1996, pages 9-13) without disagreement from the Examiner for over such six years, as fully met by applicants' disclosure and invention, applicants are now met with an entirely new approach by a new Examiner, re-interpreting (actually *mis*-interpreting) the language, description and meaning of applicants' specification suddenly to be not supportive of the language of the claims, under 35 U.S.C. §112.

Not once, in the numerous status requests, oral and written communications with the first Examiner (see attached chronology over this six-year period) did the Examiner raise any issue with the adequacy of applicants' specification to support a single one of these claims! To the contrary, there was always the promise of the declaration of interference "soon" -- particularly after the favorable result of the Cotte et al re-examination procedure as to certain claims copied by applicants (including claim 1).

The first Examiner, indeed, issued a suspension of prosecution order on March 1, 1999 "pending the outcome of re-examination 90/004,486" (Cotte et al U.S. Patent No. 5,499,108) pursuant to the provisions of the Manual of Patent Examining Procedure (MPEP) - Sec. 2307.04. The MPEP however specifically *restricts* the use of such a suspension action to cases *in condition for allowance*:

"This paragraph should only be used when the application is otherwise in condition for allowance".

This is clearly further evidence that the Examiner then handling this application considered that claims 1 and 32 (and claims 2-31 and 33-50) not only contained subject

matter which was adequately described in applicants' specification or inherent therein, but that such claims were otherwise allowable to applicants.

Indeed, if such were not the case (as the new Examiner now belatedly tries to urge), the MPEP required that "Prosecution of the application should continue as far as possible" - - and certainly a 35 USC§112 rejection would have fallen within the duty of the Examiner, if actually appropriate, as mandated by MPEP Sec. 707.07(g):

"The Examiner ordinarily should reject each claim on all valid grounds available..."

The new Examiner's new and inappropriate tack, furthermore, flies in the face of the very prohibition of Sec. 706.04 (MPEP) that

"Full faith and credit should be given to the search and action of a previous examiner unless this is a clear error in the previous action or knowledge of other prior art. In general, an examiner should *not* take an entirely new approach or attempt to reorient the point of view of a previous examiner..."

Withdrawal of this improper and belated §112 rejection, and the prompt declaration of an interference is therefore respectfully requested. This six year+ delay, none of it the doing of the applicants, and the future delay in an interference proceeding, may well have destroyed the commercial viability of an ultimate patent to applicants; but putting further obstacles in applicants' path exacerbates the possibly irreparable harm the Patent Office has unjustly caused the applicants.

Altogether apart from improperly further delaying applicants' right to a patent, moreover, the new Examiner's assertions that the

"subject matter... was not disclosed in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, had possession of the claimed invention",

are, with respect, just technically and otherwise utterly incorrect!

With specific regard to independent claims 1 and 32, the new Examiner erroneously states: "however, there is no description in the specification to support the

feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said placement...."

Quite to the contrary, however, applicants' specification (pages 13 and 14) describes:

"In this mode of operation, the master device is the keyboard-scanner of the invention, and the computer is used as a slave output device for display communication and printing...."

Master/slave is described where the scanner is a master and the personal computer is used as a slave output device for display communication and printing.

This description alone means to a person skilled in the art, that when the scanner transfers data to the "slave" computer for display, there is no further action required on the "slave output device" for the data to be displayed. For example, a printer is a "slave" device of a PC in regular PC configuration. When the computer sends data to the printer, the "slave" printer prints it as soon as it can. There is no further action needed to be performed by the user on the "slave" printer itself.

Furthermore, at pages 18 and 19, there is a description of a "master" mode of operation as follows:

"Master mode- the scanner automatically starts scanning, initiates communication protocol with the host computer and the host receives the scanned data into a "spool" directory where it is stored for application to retrieve it".

In such "master mode", the computer is used as a slave input/output device which responds to the "master" display, communicate and print commands. The use of the "spool directory" is further well known to persons skilled in the art. When a "master" device sends data to a shared "slave" device (such as a printer), the master actually sends the data to a spool directory and the data is written to the slave device as soon as it is free to receive it. On the MS-Windows operating system, for example, the user can either set the "Spool" function to wait for the completion of the document before sending it to the output device, or do it while it still receives the document.

There was nothing new in the art at the time of applicants' application in having the output operation done while creating the document's data. In applicants' patent application, the term "spool directory" is used precisely to describe how the output operation is done as understood by a person with knowledge in the art. It is and was a well known option of using spool operation, to output the document to the output device while it is being created on the spool device without waiting first for the end of the document. Applicants, indeed, have disclosed the use of the computer as an output slave device for display of the scanner "master" application data, which means that any of the scanner application data to be displayed may go to the computer display without any further action on the computer. Selection of menu functions is (and was at the time of the filing of the application) an obvious and well-known and inherent operation for ANY APPLICATION in the art.

On page 4 of the current Office action, the Examiner refers to the limitations "scanning means sends an interrupt to said computer... however, nowhere in the specification discloses such limitation above..." The present application, however, clearly discloses a "Master" mode where the scanner is the master and the computer is the slave. It is well known that this operation can *only* use one of two options - - polling or interrupts for master/slave operation, both inherent and well-known techniques in the art. Actually, there are *no other* options but to poll or interrupt.

The scanner function described by applicants indeed is to produce image data. As mentioned before, applicants have disclosed the use of the PC as a slave display device for the scanner, which means it is going to display the image data, which, indeed, is the *only* data produced by the scanner!

The Office has further questioned applicants' disclosure of the limitation reading "In dependent claims 20 and 26... (of) a plurality of user selectable options... wherein said placement alone is sufficient to initiate...".

As mentioned before, applicants have fully disclosed that document placement *alone* is sufficient to start the scanning application in the "master" mode. Further they have disclosed that in such "master" mode, the PC IS USED AS A SLAVE OUTPUT DISPLAY, which, for anyone skilled in the art, means that any of the then conventional and inherent output or menu selection will be done on the slave display. Menu selection by itself was the common and universal means of operation and well-known behavior of any and all of "MS-Window" or MAC or X-Window (UNIX) etc. applications at the time of the present application.

The first Examiner, in holding for over six years that applicants' disclosure supported claim 1, etc., was thus entirely correct -- whereas the newly raised objection is totally incorrect.

Reconsideration of the rejection and prompt declaration of an interference -- at the very least on the basis of claim 1 -- appear to be in order and are respectfully requested.

Further to expedite the prosecution and simplify the issues -- applicants, believing that they have already been seriously and perhaps by now irreparably injured by the Patent Office delays--have reduced the number of claims; and such claim cancellations are accordingly in no way to be perceived as a disclaimer.

Applicants do not understand the criticism of the drawings offered by the new Examiner since the drawings have long-since been approved and printed in connection with parent application 472, 573, now US Patent No. 5, 623, 285.

The Office is respectfully requested, in view of the long prosecution delay, to respond promptly, though applicants, in view of their return to living in the Middle East, with its recent terrorist activities and war, were unable to provide prompter information to counsel for responding to the Office action, and must take advantage of

the statutory provisions for reply time extensions, petition for which is hereby made,
with any and all costs to be charged to account no. 18-1425 of the undersigned
attorneys.

Respectfully submitted,

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